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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,061	04/26/2001	Nancy Elisabeth Krauss	R0070B-REG	9572

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EXAMINER

WARD, PAUL V

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/844,061	Applicant(s) KRAUSS ET AL.	
	Examiner PAUL V. WARD	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 28-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 28-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments, with respect to claims 1-19 and 28-43 and the rejections under 102(b) and 103(1) by Sato, Berman and Okada, have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

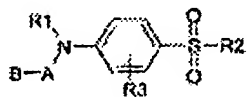
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Asberom et al. (WO 98/01425).

Applicants claim a compound of formula I:



wherein all the variables are defined in the claims.

Asberom teaches a compound, which share the same formulaic compounds. (See Abstract). The compound in the said reference, **formula If**, has the same structure, and falls within the range of Applicant's compounds. (See page 7, Method B, formula If). Since Asberom teaches the exact compounds, Applicants' claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

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2. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Sebti et al. (WO 98/50029).

Sebti teaches a compound, which share the same formulaic compounds. (See Abstract). The compounds in the said reference, **N-[4-benzyl-N-(4-sulfonamidophenyl)aminomethyl-2(20methylphenyl)benzoyl]methionine**, **N-[4-benzyl-N-(4-sulfonamidophenyl)aminomethyl-2(20methylphenyl)benzoyl]methionine, lithium salt**, **N-[4-N-benzyl-N-(4-sulfonamidophenyl)aminomethyl-2(2-methylphenyl)benzoyl]methionine**, **N-[4-N-benzyl-N-(4-sulfonamidophenyl)aminomethyl-2(2-methylphenyl)benzoyl]methionine, lithium salt**, have the same structure, and falls within the range of Applicant's compounds. (See pages 454-457, Examples 999-1000). Since Sebti teaches the exact compounds, Applicants' claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

3. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Balinska et al. (Anticancer Research-1997).

Balinska teaches a compound, which share the same formulaic compounds. (See Figure 1). The compounds in the said reference, **2-desamino-2-methyl-10 propargyl-5,8-dideazapteroyl-glycine** and **2-desamino-2-methyl-10 propargyl-5,8-dideazapteroyl-glutamine**, have the same structure, and falls within the range of Applicant's compounds. (See page 4520). Since Balinska teaches the exact compounds, Applicants' claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

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4. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Balinska et al. (Acta Biochimica Polonica-1997).

Balinska teaches a compound, which share the same formulaic compounds. (See Figure 1). The compounds in the said reference, **2-desamino-2-methyl-10 propargyl-5,8-dideazapteroyl-glycine** and **10 propargyl-5,8-dideazafolic acid**, have the same structure, and falls within the range of Applicant's compounds. (See page 744). Since Balinska teaches the exact compounds, Applicants' claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

5. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada et al. (CPB-1997).

Okada teaches a compound, which share the same formulaic compounds. (See Table 1). The compound in the said reference, **Compound 4d—5-[(4-bromobenzyl)amino]pyrimidine (derivatives)**, has the same structure, and falls within the range of Applicant's compounds. (See page 1294). Since Okada teaches the exact compounds, Applicants' claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

6. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al. (JMC-1996).

Jones teaches a compound, which share the same formulaic compounds. (See Scheme 1<sup>a</sup> and 2<sup>a</sup>, and Compounds 32 and 35). The compounds in the said reference, **Compounds 7n and 7o** (page 906), **Compounds 32 and 35** (page 907), and **Compounds 17 and 18** (page 908) has the same structure, and falls within the range of

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Applicant's compounds. Since Jones teaches the exact compounds, Applicants' claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

7. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Dinsmore et al. (BMCL-1999).

Dinsmore teaches a compound, which share the same formulaic compounds. (See Table 4). The compounds in the said reference, **Compounds 8e-f** have the same structure, and falls within the range of Applicant's compounds. (See page 3304). Since Dinsmore teaches the exact compounds, Applicants' claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asberom et al. (WO 98/01425).

Asberom teaches a generic group of sulfonyl phenyl amino derivatives, which embraces Applicants' claimed compounds. (See formula 1 and definitions). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the

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reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

9. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebti et al. (WO 98/50029).

Sebti teaches a generic group of sulfonyl phenyl amino derivatives, which embraces Applicants' claimed compounds. (See formula 1 and definitions). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to

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render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

10. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balinska et al. (Anticancer Research-1997).

Balinska teaches a generic group of sulfonyl phenyl amino derivatives, which embraces Applicants' claimed compounds. (See Figure 1 and definitions). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

11. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balinska et al. (Acta Biochimica Polonica-1997).

Balinska teaches a generic group of sulfonyl phenyl amino derivatives, which embraces Applicants' claimed compounds. (See Figure 1 and definitions). The claims differ from the reference by reciting specific species and a more limited genus than the



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reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

12. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (CPB-1997).

Okada teaches a generic group of sulfonyl phenyl amino derivatives, which embraces Applicants' claimed compounds. (See Table 1 and definitions). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the

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reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

13. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (JMC-1996).

Jones teaches a generic group of sulfonyl phenyl amino derivatives, which embraces Applicants' claimed compounds. (See Scheme 1<sup>a</sup> and 2<sup>a</sup>, compounds 32 and 35, and definitions). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

14. Claims 1-19 and 28-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinsmore et al. (BMCL-1999).

Dinsmore teaches a generic group of sulfonyl phenyl amino derivatives, which embraces Applicants' claimed compounds. (See Table 4 and definitions in 8e-f). The

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claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

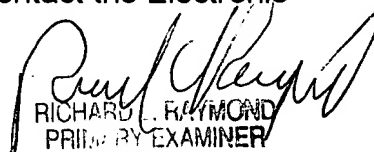
### **Conclusion**

Claims 1-19 and 28-43 are pending. Claims 1-19 and 28-43 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V. WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624